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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,079	09/23/2003	Stephen L. Ward	000850-10	2691

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EXAMINER
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THOMPSON, KENNETH L

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 03/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/669,079	<b>Applicant(s)</b> WARD ET AL.	
	<b>Examiner</b> Kenneth Thompson	<b>Art Unit</b> 3672	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 November 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-25 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 November 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Drawings*

The drawings are objected to because the sectional designations 1, 2, 3, 4 and 5 in figures 3 and 3.1 should be changed to A, B, C, D, and E respectively; to be correlated as below,

Fig. 3A is a cross-sectional view of Fig. 3 taken along section lines A of Fig. 3,

Sectional designations 3 and 4 in the figures above, not corresponding to sectional views, should be deleted.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

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be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-25 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-25 of copending Application No. 10/636,947. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

Claims 1-25 of Application No. 10/636,947 are duplicates of claims 1-25 of the current application.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending

application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Ward, US 2005/0028977.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Regarding claims 1-25, Ward discloses in figures 1-6 all the claimed limitations including the base pipe (1) having shunt tubes (7), support rods (34) and wire wrap (32).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 8-11, 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Bryant et al., U.S. 5,868,200.

Regarding claims 1, 2, 10, 11 and 15, Bryant et al. discloses in figures 1-3 a plurality of joints (11) a base pipe (12) having openings (12c), an outer surface (17) having sections (19) permeable to fluids and abating the flow of particulate material, mounted over the base pipe to form an annulus. Bryant et al. discloses exit nozzle chambers (within 30) secured to the outer surface, a multiple number of the shunt tubes (14) radially spaced around the base pipe (12) positioned inside the annulus and secured (via 18) to the inside of the outer surface. Bryant et al. discloses multiple exit ports (33), the exit nozzle chambers being connected to the shunt tube (14) communicating with the outside of the outer surface of the screen (via 33), a coupling (16) joining adjacent ones of the joints together forming a common manifold area with chambers; and an outer member (30) having side openings (openings of 30 radially inward 33, of 34) permitting fluid flow to the annulus (through 33) from the exterior to the outer surface (via 19,15,14,13,12c).

As to claim 8, as best understood by the Examiner, Bryant et al. discloses in figure 1 the section of exit nozzle chamber (within 30) placed over the base pipe (12) and alternates with sections of the outer surface (17).

As to claim 9, Bryant et al. discloses the exit ports (33) of exit nozzles includes material (34) used for erosion abatement.

As to claim 12, Bryant et al. discloses a fluid means (15) for fluid in slurry to return to the flow stream in the shunt tubes (14).

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As to claim 14, Bryant et al. discloses connection means (16) for joining adjacent ones of the joints, a fluid means (15) for the fluid to return to the flow stream (inner bore of 12) in the base pipe (12); a slotted external concentric pipe (11a) positioned between the exit nozzle chamber (within 30) that is the highest mounted and the threaded box (next highest coupling 16), the bored channel (31) being in fluid connection with the annulus (via 33) and in further fluid communication with the flow stream in the base pipe (via 15,14,13,12c).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-7 and 16-25 are rejected under 35 U.S.C. 102(a) as being anticipated by Hailey, Jr., U.S. 6,581, 689.

Regarding claims 1 and 2 Hailey, Jr. discloses a base pipe (62) having openings (66), an outer surface (84;122,124) having sections (92,94) permeable to fluids and abating the flow of particulate material, mounted over the base pipe to form an annulus. Hailey, Jr. discloses exit nozzle chambers (108) secured to the outer surface, a shunt tube (104) positioned inside the annulus. Hailey, Jr. discloses multiple exit ports (106), the exit nozzle chambers being connected to the shunt tube (104) communicating with the outside of the outer surface of the screen (col. 6, line 41-57); and an outer member (126) having side openings (132) permitting fluid flow to the annulus from the exterior to the outer surface.

As to claims 3-6, Hailey, Jr. discloses longitudinal support rods (70) and shunt tubes (104), are welded to the inside of the outer surface (col. 6, lines 23-49).

As to claim 7, Hailey, Jr. discloses the outer surface includes multiple sections of a wire (84;122,124), each wrap of the wire being spaced from the adjacent wraps to create openings (92,94) between the wraps of wire.

Regarding claims 16 and 22, Hailey, Jr. discloses providing the arrangement of conduits (70,104) positioned between the base pipe (62) and the screen (122,124) in the tube annulus (108) and connected to the exit nozzle chambers (within 102); filling the well annulus and tool interior with gravel slurry until the well annulus is blocked (col. 8, line 63 - col. 9, line 11); after step B, flowing the gravel slurry into the conduits in the tube annulus past the well annulus block; causing the gravel slurry flow of step C to flow from the tube annulus through the exit nozzle chambers to the well annulus.

As to claims 17-21, Hailey, Jr. discloses the conduits (104,70) are un-perforated flow conduits, alternate flow paths, shunt tubes, round conduits col. 6, lines 1-4) spaced radially around the base pipe within the tube annulus.

As to claim 23, Hailey, Jr. discloses the well bore is sealed (at 44).

As to claim 24, Hailey, Jr. discloses the gravel slurry flows through the interior of the tool and through a crossover tool to flow into the well annulus (col. 8, line 63 - col. 9, line 11).

As to claim 25, Hailey, Jr. discloses the gravel slurry flows from the annulus through the screen to the shunt tubes and returns through the interior of the tool (col. 8, line 53-63).



***Allowable Subject Matter***

Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form to overcome the objections set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record does not disclose or suggest all the claimed subject matter including the fluid means includes a box end at one end of the base pipe, the box end having threads for attachment to an adjacent one of the plurality of joints, an external circumferential groove above the threads; and a slotted plate covering the external circumferential groove.

***Response to Arguments***

Applicant's arguments filed 18 November 2005 have been fully considered but they are not persuasive.

Applicants should note that double patenting and 35 U.S.C. 102(e) rejections above will be removed after stated actions have been taken by the Applicant's assignee.

Applicant argues the manifold of Hailey, Jr is not comparable to Applicant's nozzle chamber.

Applicant's nozzle chamber is not claimed nor disclosed with the degree of specificity required to preclude comparison to the annular manifold of Hailey, Jr. having the shunt tubes and ports substantially as claimed.

Applicants arguments with respect to the annular area within sleeve 30 being compared to the claimed nozzle chambers is answered essentially as above.

Applicants arguments with respect to claims 8, 9, 11, 12 and 14 amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims (specifically the functional recitations) patentably distinguishes them from the references.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

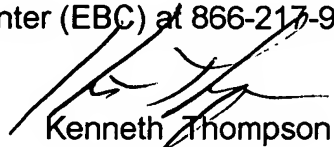
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth Thompson whose telephone number is 571 272-7037. The examiner can normally be reached on 7:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

21 February 2006



Kenneth Thompson  
Primary Examiner  
Art Unit 3672